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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/522,864 | 09/02/2005 | Peter Dietrich | GK/ZEI-3263/500343.20283 | 4722 |

26418 7590 04/18/2006

REED SMITH, LLP
ATTN: PATENT RECORDS DEPARTMENT
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

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| EXAMINER |
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HASAN, MOHAMMED A

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| ART UNIT | PAPER NUMBER |
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2873

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/522,864

Applicant(s)

DIETRICH, PETER

Examiner

Mohammed Hasan

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-17 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-11, 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 12, 13, 16 and 17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152..

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/2/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Oath/Declaration

1. Oath and declaration filed on 9/2/2005 is accepted.

Information Disclosure Statement

2. The prior art documents submitted by applicant in the Information Disclosure Statement filed on 9/2/2005 have all been considered and made of record (note the attached copy of form PTO – 1449).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-11,14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kapitza (5,896,224).

Regarding claim 9,Kapitza discloses (refer to figure 3) an optical arrangement with telecentric beam region for imaging objects (40) (column 5, lines 16-17),

comprising: at least one infinity-imaging objective, at least one eyepiece (45) and a tube lens (41) of suitable focal length which is arranged between the two at a fixed distance from the objective, at least one optical element for laterally splitting off (44) at least a first partial beam path being provided in the space between the objective and the tube lens in which a telecentric beam path is located and a tube lens (41) being located at a suitable distance from the objective in each of first partial beam paths (column 5, lines 16-22, column 6, lines 60-65).

Regarding claim 10, Kapitza discloses, wherein at least a second partial beam path is branched off from at least one of these first partial beam paths, and wherein a tube lens (41) is located at a suitable distance from the objective in each of these second partial beam paths (as shown in figure 3).

Regarding claim 11, Kapitza discloses, wherein at least a third partial beam path is branched off from at least one of these second partial beam paths and wherein a tube lens (41) is located at a suitable distance from the objective in each of these third partial beam paths (as shown in figure 3).

Regarding claim 14, Kapitza discloses, wherein interchangeable devices or modules are provided which carry beam splitter (44) elements and which are coupled with controllable drive (48) units for the purpose of insertion into the respective partial beam path (column 5, lines 45-46).

Regarding claim 15, Kapitza discloses, wherein the beam splitter (44) elements are arranged in the interchangeable devices in an exchangeable manner (as shown in figure 3).

Allowable Subject Matter

4. Claims 12,13,16,and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to show the tube lenses are arranged in the first, second, and third partial beam paths have the same focal length or different focal length and beam splitter elements are provided for branching the first, second and third partial beam paths, wherein these beam splitter elements are arranged in the space between the objective and the respective tube lens of the partial beam path to be branched, and diaphragms or optical filters, particularly interference filter, color filters or polarizing filters, which serve to influence the optical characteristics of the light of the respective partial beam path are arranged in the first partial beam paths, second partial beam paths and or third partial beam paths and the optical filters are interference filters, color filters or polarizing filters.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The closest prior art as follows:

Bierleutgeb (4,935,612) discloses an autofocus system and method of using the same.

Kawano et al (6,597,499 B2) discloses a total internal reflection fluorescence microscope having a conventional white-light source.


Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammed Hasan whose telephone number is (571) 272-2331. The examiner can normally be reached on M-TH, 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L Mack can be reached on (571) 272- 2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MH
April 13, 2006


Scott J. Sugarman
Primary Examiner